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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,129	06/27/2003	Toshitaka Iwago	116194	5569
25944	7590	11/15/2005	EXAMINER	
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			GHATT, DAVE A	
			ART UNIT	PAPER NUMBER
			2854	

DATE MAILED: 11/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

AK

<b>Office Action Summary</b>	<b>Application No.</b> 10/607,129	<b>Applicant(s)</b> IWAGO ET AL.	
	<b>Examiner</b> Dave A. Ghatt	<b>Art Unit</b> 2854	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 September 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 and 17-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 24 and 25 is/are allowed.
- 6) ☒ Claim(s) 1-3 and 17-22 is/are rejected.
- 7) ☒ Claim(s) 4-11, and 23 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
- 1. ☒ Certified copies of the priority documents have been received.
  - 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/29/05</u> . | 6) <input type="checkbox"/> Other: _____  |

DETAILED ACTION

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear what structure the applicant intends to claim in claim 22. Claim 1 (from which claim 22 depends) appears to claim the embodiment of a tray illustrated in Figure 29, which comprises a fixed/one-piece projection. Claim 22 recites the tray, "wherein the projection is movable from an extended state to a contracted state." Because of the claim 1 requirement for fixed/one-piece projection to be movable, it is unclear as to how the projection is movable. Because of this indefiniteness and inconsistency, prior art was not applied to claim 22.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2, 17, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Dworkin (US 4,300,248). Insofar as structure is recited, Dworkin teaches the claimed apparatus. As shown in Figure 1, Dworkin teaches a tray comprising, a surface with a first end (shown

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generally at 24), and a second end (shown generally at 26) opposite to the first end, a projection 16 extending away from the surface and from the second end of the surface. As outlined in column 4 lines 21-27, the projection 16 is formed integrally with the surface as a one-piece member. Figures 1 and 2 teach a recess formed below the surface and from the projection toward the first end.

With respect to the intended use language of claim 2, the applicant should note because Dworkin teaches the recited structure, therefore Dworkin is capable of performing the intended functions.

With respect to claim 17, as shown in the cross-section of Figure 2, the recess of Dworkin is not symmetrical because of the lip portion (shown generally at 32 in Figure 1).

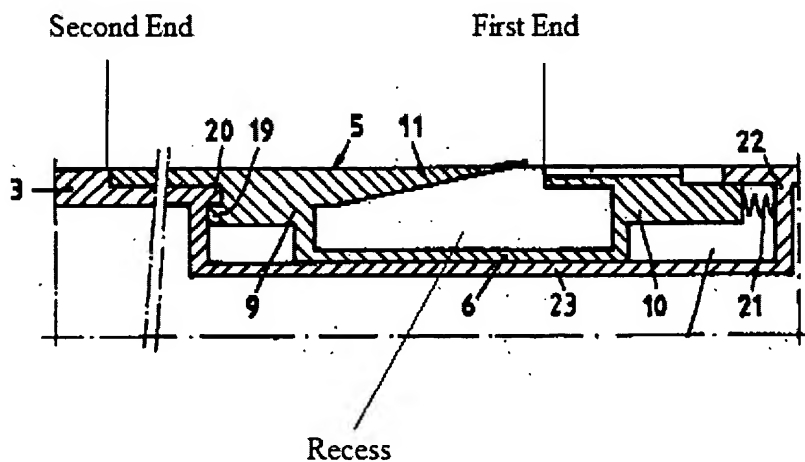
With respect to the language of claim 19, the applicant should note that Dworkin teaches the recited structure, and is therefore capable of having a combined width that is shorter than the width of documents discharged on the surface.

5. Claims 1-3, 17, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Hovens et al. (US 4,473,220). Insofar as structure is recited, Hovens et al. teaches the claimed apparatus. As shown in the examiner's marked-up copy of Figure 3, Hovens et al. teaches a tray 5. As shown in marked-up Figure, Hovens et al. teaches a surface with a first end, and a second end opposite to the first end, a projection 11 extending away from the surface and from the second end of the surface. As shown below, the projection 11 is formed integrally with the surface as a one-piece member. The marked-up Figure also teaches a recess formed below the surface and from the projection toward the first end.

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With respect to the intended use language of claim 2, the applicant should note because Hovens et al. teaches the recited structure, therefore the teaching of Hovens et al. is capable of performing the intended functions.

Examiner's Marked-Up Version of Figure 3



With respect to claim 3, as shown in Figure 1, Hovens et al. teaches the first end connected to a feeding device (copying machine) that feeds documents.

With respect to claim 17, as shown in the cross-section of Figure 3, the recess of Hovens et al. is not symmetrical.

With respect to the language of claim 19, the applicant should note that Hovens et al. teaches the recited structure, and is therefore capable of having a combined width that is shorter than the width of documents discharged on the surface.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dworkin (US 4,300,248) in view of Southard (US 4,993,546). As outlined above, Dworkin teaches all the claimed subject matter, except for a recess width that decreases with proximity to the first end. Southard teaches a structure similar to that of Dworkin, the Southard structure having curved walls (shown generally at 12 and 13). Because of the curved Southard structure, a recess width decreases with proximity to a first end. To one of ordinary skill in the art, it would have been obvious to include in the structure of Dworkin, a curved shape (with a decreasing width) as taught by Southard, for the advantage of self-draining, as taught by Southard in column 1 lines 51-55.

8. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dworkin (US 4,300,248) in view of Kelley (US 5,509,529). As outlined above, Dworkin teaches all the claimed subject matter, except for a recess depth that increases with proximity to the first end.

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Kelley teaches a structure similar to that of Dworkin, the Kelley structure having a ribbed based between first and second ends. Because of the ribbed Kelley structure, a depth of the recess formed below the surface increases (and decreases) with proximity to the first end. To one of ordinary skill in the art, it would have been obvious to include in the structure of Dworkin, a ribbed shape (with an increasing depth) as taught by Kelley, for the advantage of preventing slippage from the recess.

9. Claim 21 is rejected under 35 U.S.C. 103(a) as being obvious over Hovens et al. (US 4,473,220) in view of Tokunoh (US 5,515,153). As outlined in the above rejection of claim 1, Hovens et al. teaches an imaging arrangement with all the claimed structure, except Hovens et al. is silent as to whether the cover, which supports the tray 5, is attached to an automatic document feeder. Tokunoh teaches an imaging arrangement similar to that of Hovens et al. As shown in Figures 1 and 2, Tokunoh teaches a cover with a tray 152 similar to that of Hovens et al., the Tokunoh tray 152 attached to an automatic feeding device 4, thereby being located at an upstream side of a feeding device that feeds documents. To one of ordinary skill in the art, it would have been obvious to have the cover and tray arrangement of Hovens et al., located upstream of feeding device, as taught by Tokunoh, for the benefit of enabling the continuous feeding of multiple documents.

***Allowable Subject Matter***

10. Claims 4-11, and 23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 4 is indicated as having allowable subject matter because the prior art of record does not teach or render obvious the total combination claimed, wherein the tray is a discharge tray located at a downstream side of a feeding device.

Claim 23 is indicated as having allowable subject matter because the prior art of record does not teach or render obvious the total combination claimed, including an image forming apparatus in which the tray receives the document after the image recorded on the document has been read by the image reading device.

11. Claims 24 and 25 are allowed.

Claim 23 is allowed because the prior art of record does not teach or render obvious the total method, including feeding documents to a scanner one by one, and discharging the scanned document to a discharge tray with a surface with a first end and a second end opposite to the first end, and a projection extending away from the surface, wherein the projection is formed integrally with the surface as a one-piece member.

***Examiner Comments***

12. The R.C.E. filed September 29, 2005 has been fully considered by the examiner. The references cited in the I.D.S. have been reviewed. The applicant should note that claims 1-3 and



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17-21 have been rejected as being unpatentable in view of newly discovered references. See the attached PTO-892. Also, claim 22 has been rejected under 35 U.S.C. 112 Second Paragraph.

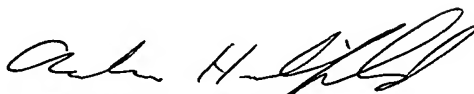
***Conclusion***

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave A. Ghatt whose telephone number is (571) 272-2165. The examiner can normally be reached on Mondays through Friday 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew H. Hirshfeld can be reached on (571) 272-2168. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DAG

  
**ANDREW H. HIRSHFELD**  
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